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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/799,191

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Gillian Munro Burgess

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09/21/2006

PFIZER INC.

PATENT DEPARTMENT, MS8260-1611

EASTERN POINT ROAD

GROTON, CT 06340

EXAMINER

ZHANG, NANCY L

ART UNIT

PAPER NUMBER

1614

DATE MAILED: 09/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/799,191

Applicant(s)

BURGESS ET AL.

Examiner

Nancy L. Zhang

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-49 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 18-49, drawn to a product of a PDE5 inhibitor in combination with an active agent, classified in class 514, subclass 3. If this group is elected, the below summarized species election is also required.
- II. Claims 1-17, drawn to a method of treating type 1 diabetes by administering a PDE5 inhibitor in combination with an active agent, classified in class 514, subclass 3. If this group is elected, the below summarized species election is also required.

The inventions are distinct, each from the other because of the following reasons:

Inventions in Group I and Group II are related as product and process of use.

The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the product as claimed can be used in a materially different process of using that product because a combination of a PDE5 inhibitor sildenafil and an active agent raloxifene can be used in a method of treating timidity in post menopausal women enhancing libido in postmenopausal women.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

***Species election for Groups I***

Invention in Group I contains claims directed to the following patentably distinct species:

(I-A) the product is a pharmaceutical combination comprising a PDE5 inhibitor and an active agent.

(I-B) the product is kit comprising a PDE5 inhibitor, means for testing for Type 1 diabetes, one or more additional active agent, and instructions for treatment of Type 1 diabetes.

The species are independent or distinct because different components are included in the product. A component of “means for testing for Type 1 diabetes” in the kit can include many different chemical compounds that may not be related to the PDE5 inhibitor or the active agent in the product.

In addition, further species election is required as follows for the PDE5 inhibitor in the product being:

(I-a1) sildenafil

(I-a2) not sildenafil but is a compound in the list of claim 19; the applicant is required to specify one single compound from the list.

Art Unit: 1614

(I-a3) any PDE5 inhibitor that is not listed in claim 19.

Further species election is also required as follows for the active agent in the product being:

(I-b1) one of the agent as listed in claim 21; the applicant is required to specify one single agent from the list.

(I-b2) not (I-b1), but is an agent from the list in claim 20; the applicant is required to specify one single agent.

(I-b3) not (I-b1)-(I-b2), but is an agent from the list in claim 18; the applicant is required to specify one single agent.

The above listed species are independent or distinct because they are different compounds or chemicals having different structures, binding activities and biological effects.

### ***Species election for Groups II***

Invention in Group II contains claims directed to the following patentably distinct species:

(II-A) a method of treating type 1 diabetes by administering a PDE5 inhibitor with no additional active agent

(II-B) method of treating type 1 diabetes by administering a PDE5 inhibitor in combination with an additional active agent.

These species are different because different components are used in the method of treatment. Different components are different chemicals having different

Art Unit: 1614

binding activities and biological effects. The presence or absence of an additional active agent would result in different treatment effects.

In addition, further species election is required as follows for the PDE5 inhibitor being:

(II-a1) sildenafil

(II-a2) not sildenafil but is a compound in the list of claim 2; the applicant is required to specify one single compound from the list.

(II-a3) any PDE5 inhibitor that is not listed in claim 2.

Further species election is also required as follows for the active agent being:

(II-b1) one of the agent as listed in claim 4; the applicant is required to specify one single agent from the list.

(II-b2) not (II-b1), but is an agent from the list in claim 3; the applicant is required to specify one single agent.

The above listed species are independent or distinct because they are different compounds or chemicals having different structures, binding activities and biological effects.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, all claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim

is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a). Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Notice of Possible Rejoinder***

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result**



Art Unit: 1614

**in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nancy L. Zhang whose telephone number is (571)-272-8270. The examiner can normally be reached on Mon.- Fri. 8:30am - 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on (571)-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*NLZ* 9/8/06  
NLZ

*Ardin H. Marschel* 9/16/06  
ARDIN H. MARSCHEL  
SUPERVISORY PATENT EXAMINER